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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES V. LOVENSTEIN and JAMES R. MOSS

Appeal 2008-2840
Application 10/729,045
Technology Center 2800

Decided: September 30, 2008

Before THOMAS A. WALTZ, JEFFREY T. SMITH, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 1-10, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellants, the invention is directed to a device and a method that enables rapid, efficient mounting of a recording member, such

as a lithographic plate, to a plate cylinder for printing (App. Br. 3).¹ The claimed invention utilizes one or more magnetic retention devices each having a curved surface complementary to the cylinder, such that when disposed on the plate the retention devices magnetically adhere the plate to the underlying cylinder (*id.*). The invention is illustrated by independent claim 1, as reproduced below:

1. A retention device for securing a recording medium to a rotatable, magnetically susceptible cylinder, the retention device being configured for releasable attachment to the cylinder over the recording medium and comprising a curved surface complementary to the curvature of the cylinder and, associated with the surface, at least one magnetic element.

The Examiner has relied on the following prior art references as evidence of obviousness:

Zerillo	6,688,227 B2	Feb. 10, 2004
Kerr	6,729,235 B2	May 4, 2004

ISSUE ON APPEAL

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Zerillo in view of Kerr (Ans. 3).

Appellants contend that, as recognized by the Examiner, Zerillo does not teach or suggest a retention device with a curved surface (App. Br. 5). Appellants further contend that Kerr doesn't cure this deficiency since Kerr is silent with respect to the shape of the inner surface of the retention device (*id.*). Appellants contend that Figs. 14 and 15b of Kerr depict the retention device as having flat, straight surfaces that do not follow the curvature of the drum or cylinder (*id.*). Appellants also contend that the top surfaces 56, 57

¹ We refer to and cite from the "Amended Appeal Brief" dated May 1, 2007.

of the retention device of Kerr are irrelevant to the claims since the inner surface of this device is flat (Reply Br. 3).

Appellants contend that, by definition, a “curved surface” is not found in Kerr but only a series of discrete, flat inner surfaces (App. Br. 7). Appellants further contend that a curved surface could be detrimental to the retention device of Kerr (*id.*).

Appellants contend that the Examiner’s findings regarding Zerillo are contradictory, since the Examiner has admitted that Zerillo does not disclose a curved surface but later states that Zerillo appears to disclose a curved surface (Reply Br. 3-4).

The Examiner contends that Zerillo does not explicitly disclose a retention device with a curved surface complementary to the curvature of the cylinder (Ans. 3). However, the Examiner finds that Zerillo “appears to teach a curved retention device (50)” as shown in Figs. 1, 4, and 5 (Ans. 5).

The Examiner contends that Kerr teaches a curved retainer device to hold and secure a sheet material to a cylinder (Ans. 3). The Examiner contends that Fig. 15b of Kerr clearly shows retaining device 50 with an overall curvature to match the curvature of the cylinder/drum 28 (Ans. 5). The Examiner concludes that it would have been obvious to one of ordinary skill in this art to use the curved retention device taught by Kerr to properly secure sheets in the device of Zerillo (Ans. 3-4).

Accordingly, we determine the following issue presented from the record in this appeal: have Appellants established that the Examiner committed reversible error in the obviousness analysis combining Zerillo and Kerr?

We answer this question in the negative. We determine that the Examiner has properly established a prima facie case of obviousness, which prima facie case has not been adequately rebutted by Appellants' arguments. Therefore, we sustain the sole ground of rejection presented for review in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below. The decision of the Examiner is AFFIRMED.

OPINION

We determine the following Findings of Fact (FF) from the record presented in this appeal:

(1) Zerillo discloses a magnetic plate retention system for securing a lithographic plate (recording medium) to a conventional rotatable, magnetically susceptible plate cylinder, with the retention device being configured for releasable attachment to the cylinder and including at least one magnetic element (Ans. 3; Zerillo, Abstract; Figs. 1, 4, and 5; col. 1, ll. 9-12; col. 2, ll. 8-18, 29-32, and 49-50; col. 4, ll. 1-18 and 40-49);

(2) Zerillo teaches that the base 95 upon which the magnetic elements 90 are attached may be dimensioned "to permit bending and flexure of the retention device 50" as it is removed from the plate cylinder (col. 4, ll. 53-56);

(3) Kerr discloses an improved method for securing a sheet material to a rotatable imaging drum (cylinder) assembly by use of a material clamp and retainer (Abstract; Fig. 2a; col. 1, ll. 16-17, 39-41; col. 2, ll. 10-14; col. 6, ll. 31-35);

(4) Kerr exemplifies a retention device with a curved surface complementary to the curvature of the drum/cylinder to secure the sheet material to the drum (Ans. 3; Kerr, Figs. 14 and 15b; col. 11, ll. 15-30).

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations, if any. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). “[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007).

Applying the preceding legal principles to the Findings of Fact (FF) in the record of this appeal, we determine that the Examiner has established a prima facie case of obviousness. We further determine that Appellants’ arguments have not adequately rebutted this prima facie case. As shown by FF (1) listed above, and not disputed by Appellants (App. Br. 5), we determine that Zerillo discloses a retention device as recited in claim 1 on appeal, with the exception that there is no explicit disclosure of a retention device having “a curved surface complementary to a curvature of the cylinder” (Ans. 3).² However, we agree with the Examiner that it would have been obvious to one of ordinary skill in this art to employ a curved surface complementary to the curvature of the cylinder for the retention device disclosed by Zerillo for the following reasons. First, we determine that the retention device disclosed by Zerillo appears to be curved slightly, at

² Appellants do not present arguments specific to any individual claim (*see* the App. Br. and Reply Br. in their entirety). Accordingly, pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we select claim 1 from the grouping of rejected claims and limit our discussion to this claim.

least to the same extent that Appellants' retention device is curved (Ans. 5; *compare* Zerillo, Figs. 1, 4, and 5 with Appellants' Figs. 2 and 3). We note that the degree of curvature is not specified in claim 1 on appeal, as long as the curvature of the retention device is "complementary" to a curvature of the cylinder. Second, as shown by FF (2) listed above, we determine that Zerillo suggests a flexible retention device to one of ordinary skill in this art, and one of ordinary skill in this art would have recognized that such a flexible device was capable of bending in conformance with the curvature of the cylinder when adhered by the magnetic elements. Third, as shown by FF (3) and (4) listed above, we determine that Kerr teaches an improved method of securing a sheet material to a rotatable, magnetically susceptible cylinder where the retention device includes retaining surfaces 56, 57 which clearly have *inner* surfaces which are curved in conformance to the curvature of the cylinder (*see* Fig. 15b of Kerr).

Appellants argue that Figs. 14 and 15b of Kerr depict "flat, straight surfaces that **do not** follow the curvature of the drum" (App. Br. 5, emphasis original). As we have determined above, we do not agree with Appellants' assessment of Fig. 15b of Kerr since it appears that the outer and inner surfaces of the retaining device in Fig. 15b are curved in conformance with the curvature of the drum/cylinder. We note that Appellants admit that the top surface of the fixture 50 is curved (Reply Br. 3). Furthermore, Appellants have not refuted the Examiner's position that the retaining device 50 of Kerr must have an overall curvature to match the curvature of the drum 28 or the retaining device would not function effectively to secure sheet material to the drum (Ans. 5).

Appellants argue that the Examiner's findings from Zerillo are contradictory (Reply Br. 3-4). We do not find this argument persuasive. The Examiner's first finding is that Zerillo does not *explicitly* disclose a retention device with a curved surface (Ans. 3, emphasis added). The second finding by the Examiner from Zerillo is that Zerillo "appears" to teach a curved retention device (Ans. 5). Accordingly, we determine that these findings are not contradictory.

Appellants argue that a curved surface "may be detrimental" to the performance of Kerr's device (App. Br. 7, emphasis omitted). However, this argument is not well taken since Appellants have not provided any substantive evidence or technical reasoning to support this assertion. *See In re Scarborough*, 500 F.2d 560, 566 (CCPA 1974) (Generally held that attorney argument is insufficient to take the place of evidence or expert testimony). To the contrary, a curved surface of the retention device in conformance with the cylinder would appear to one of ordinary skill in this art to be more effective for securing the sheet material (*compare* Fig. 14 with Fig. 15b of Kerr, i.e., a flat surface retaining device of Fig. 14 with the curved surface retaining device of Fig. 15b; Ans. 5).

For the foregoing reasons and those stated in the Answer, we sustain the rejection of claims 1-10 under § 103(a) over Zerillo in view of Kerr. The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2008-2840
Application 10/729,045

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